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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,581	07/22/2003	Holger Soring	SOR 205	7516
7590 Horst Kasper 13 Forest Drive Warren, NJ 07059			EXAMINER KOHARSKI, CHRISTOPHER	
			ART UNIT 3763	PAPER NUMBER
			MAIL DATE 05/30/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/624,581	Applicant(s) SORING ET AL.	
	Examiner CHRISTOPHER D. KOHARSKI	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/05/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Examiner acknowledges the reply filed 2/01/2008 in which claims 1-17, 27, and 32 were amended. Currently claims 1-32 are pending for examination in this application. Examiner also acknowledges the amended specification and new drawing sheet of Figure 2a filed 10/15/2007 and 2/01/2008.

Information Disclosure Statement

The *information disclosure statement* (IDS) that was submitted on 10/05/2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Specification

The *title of the invention* is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The *disclosure is objected* to because of the following informalities: The specification does not disclose a description of the new Figure 2a, and does not contain any reference to the new reference numeral "30".

Appropriate correction is required.

Drawings

The drawings (Figure 2a) are objected to because it constitutes new matter. Applicant has entered a new drawing to add the sonotrode channel element, the only disclosure present was in originally filed claim 18 and the specification page 6, paragraph 3, in which the channel is disclosed to be within the sonotrode and

connected to the flushing line. The new drawing shows a specific spatial, length, connection element of the sonotrode channel to the flushing line which have no basis in the originally filed disclosure and thus are new matter. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference numeral "30". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office

action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1, 4, 6, 10, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Dieras et al. (USPN4,804,364). Dieras et al. discloses an apparatus for the curettage or exeresis of biological tissue by means of ultrasonic vibration.

Regarding claims 1, 4, 6, 10, and 32, Dieras et al. discloses a medical treatment apparatus (Figure 1) capable of being used for wound treatment with a hand piece (18) equipped with an ultrasound vibration generator (6) with electric connection means (11) and a sonotrode (14) attached to the hand piece (18), characterized in that wherein a channel (lumen of 14) is disposed within the sonotrode for feeding a medical flushing liquid to a tip of the sonotrode (near 2) via a flushing line (4) connector; wherein an adaptation sleeve (7) can be slid over the sonotrode (14) of the medical treatment apparatus and wherein the adaptation sleeve (7) can be attached at the hand piece

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(near 19), wherein the adaptation sleeve (7) is equipped with a connector (lumen near 15) for receiving a suction hose (Figures 1-7, cols 1-2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 7, 11, 13, 18-24, 26, and 30 are rejected under 35 U.S.C 103(a) as being unpatentable over Dieras et al. (USPN4,804,364) in view of Christ et al. (USPN5,984,889). Dieras et al. meets the claim limitations as described above except for a valve within the flushing line, operating at a specific frequency range, and a screw type sleeve connection.

However, Christ et al. teaches an apparatus and method for ultrasonic tissue intervention.

Regarding claims 5, 7, 11, 13, 18-24, 26, and 30, Christ et al. teaches a medical treatment apparatus (Figure 2) capable of being used for wound treatment with a hand

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piece (28) equipped with an ultrasound vibration generator (32) operating at 20-100kHz (col 4, ln 25-40) and a sonotrode (20) attached to the hand piece (28), characterized in that wherein a channel (lumen of 20) is disposed within the sonotrode for feeding a medical flushing liquid to a tip of the sonotrode (near 20) via a flushing line (near 126) connector with a valve interface; wherein an adaptation sleeve (7) can be slid over the sonotrode (14) of the medical treatment apparatus and wherein the adaptation sleeve (12) can be attached at the hand piece (near 28) via a threaded connection (Figures 1-4).

At the time of the invention, it would have been obvious to add the fluid control valve and the threaded sleeve connection in order to add fluid control and easy cleaning and disassembly of the unit. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Christ et al. (cols 1-2).

Claim Rejections - 35 USC § 103

Claims 2, 8, and 27-29 are rejected under 35 U.S.C 103(a) as being unpatentable over Dieras et al. (USPN4,804,364) in view of Christ et al. (USPN5,984,889) or (Dieras et al. (USPN4,804,364)). Dieras et al. or the modified Dieras et al. meets the claim limitations as described above except for the HEPA filter separator trap system.

However, Mallet et al. teaches a microderm suction apparatus.

Regarding claims 2, 8, and 27-29, Mallet et al. teaches a suction (10) (Figure 1) filter system (32) containing a HEPA filter (203) trap (Figure 9).

At the time of the invention, it would have been obvious to add the filter trap system of Mallet et al. to the system of Dieras et al. or the modified Dieras et al. in order to contain potentially harmful body fluids from the body. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Mallet et al. (cols 1-2).

Claim Rejections - 35 USC § 103

Claims 3, 9, 12, 14-17, 25 and 31 are rejected under 35 U.S.C 103(a) as being unpatentable over Dieras et al. (USPN4,804,364) in view of Christ et al. (USPN5,984,889) or (Dieras et al. (USPN4,804,364)). Dieras et al. or the modified Dieras et al. meets the claim limitations as described above except for the opacity of the fluid lines and ultrasound drive materials.

Regarding claims 3, 9, 12, 14-17, 25 and 31, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the fluid tubes of an opaque or non-opaque substance in order to see the contents or get optimal pressure resistance depending on the material selected and it would have been obvious to substitute the piezoelectric drive with a magneto drive since both are well known ultrasound generation means, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended

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use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Response to Arguments

Applicant's arguments, see remarks, filed 2/01/2008, with respect to the rejection(s) of claim(s) 1-32 under Banko (USPN, 3,805,787) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Dieras et al. (USPN4,804,364).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 5:30am to 2:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 4/17/2008

/Christopher D Koharski/
Examiner, Art Unit 3763

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763